

Attorney's Docket No.: 10200-007002

17

UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : David J. Luneau
Issue Date : March 14, 2000
Serial No. : Continuation of 08/660,814,¹ now
U.S. Patent No. 6,038,443, Issued
March 14, 2000
Filed : June 10, 1996
Title : CALLING PARTY ANNOUNCEMENT APPARATUS

Commissioner for Patents
Washington, D.C. 20231

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AUG 29 2001

OFFICE OF PETITIONS

Status Inquiry and Petition Pursuant To 37 C.F.R. § 1.182
To Disregard Previously Filed Request For CPA

Applicant hereby petitions pursuant to 37 CFR 1.182 to disregard a March 14, 2000, request for a Continued Prosecution Application, and to treat the March 14, 2000, paper as the filing of a continuation application under 37 CFR 1.53(b).

Introduction and Summary

The present petition and status inquiry concerns a patent application that claims priority under 35 U.S.C. § 120 from United States Patent Application Serial No. 08/660,814 ("the '814 application"). The patent application in question was filed on March 14, 2000. Although the March 14, 2000, patent application should have been filed as a continuation application under 37 CFR 53(b), it was instead filed as a continued prosecution application (CPA) under 37 CFR

¹ This application was erroneously designated a "continuing patent application" in the filing papers, and a petition is pending to change the designation to a continuation application.

08/28/2001 SLUANG1 00000105 08660814

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130.00 OP

CERTIFICATE OF MAILING BY FIRST CLASS MAIL

I hereby certify under 37 CFR §1.8(a) that this correspondence is being deposited with the United States Postal Service as first class mail with sufficient postage on the date indicated below and is addressed to the Commissioner for Patents, Washington, D.C. 20231.

August 24, 2001

Date of Deposit

Deborah L. Hamilton
Signature

Deborah L. Hamilton

Typed or Printed Name of Person Signing Certificate

117-521-7042

Applicant : David J. Luneau
Patent No. : 6,038,443
Issued : March 14, 2000
Serial No. : 08/660,814
Filed : June 10, 1996
Page : 2

Attorney's Docket No.: 10200-007002

53(d). This situation was the subject of a petition filed on June 10, 2000. However, no action has apparently been taken on the previous petition, and Applicant seeks to inquire into the status of that previous petition. In addition, in accordance with MPEP § 201.06(d), as further support for the relief requested in the June 10, 2000, petition, Applicant requests the PTO to disregard the previous request for a CPA, and to treat the March 14, 2000, patent application as having been filed on that date under 37 CFR 53(b).

Facts

1. On December 13, 1999, Applicant paid the issue fee for the '814 application.
2. On March 14, 2000, Applicant's previous counsel filed a Continued Prosecution Application for the '814 application, stating in part "this application is a continued prosecution application of U.S. Patent Application Serial No. 08/660,814, filed June 10, 1996."
3. Also on March 14, 2000, the '814 application issued as U.S. Patent No. 6,038,443.
4. On April 10, 2000, Applicant received a Notice of Improper CPA Filing Under 37 C.F.R. 1.53(d), dated April 10, 2000. This Notice stated that the request for a CPA was improper because it was filed after payment of the issue fee on the '814 application. As a result the March 14, 2000, patent application was not granted the March 14, 2000, filing date.
5. On June 2, 2000, Applicant's previous counsel filed a Petition Under § 1.181, requesting that the March 14, 2000, patent application be accorded the March 14, 2000, filing date. A copy of the June 10, 2000, Petition is submitted as Attachment 1.

Applicant : David J. Luneau
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6. On August 9, 2001, Applicant revoked the previous power of attorney, and appointed the undersigned counsel of record.
7. As of the filing of the present petition, Applicant and the undersigned are unaware of any action having been taken on the June 10, 2000, Petition.

Remarks

Unless accorded the March 14, 2000, filing date, the March 14, 2000, patent application will not have copendency with (and thus cannot claim priority under 35 U.S.C. § 120 from) the '814 application. The '814 application claims priority back, through a series of applications, to an application filed on January 29, 1992. Applicant is understandably interested in preserving the right to claim priority back to this early filing date through the '814 patent application.

Applicant submits that the June 10, 2000, Petition filed by Applicant's previous counsel was a timely request to be accorded the March 14, 2000, filing date. Applicant respectfully requests to be informed of the status of this petition. The Petitions Branch is invited to contact the undersigned by telephone if that would expedite consideration, or if additional information is needed.

Moreover, as additional support for the relief requested in the June 10, 2000, Petition, Applicant further petitions under 37 CFR 1.182 to treat the March 14, 2000, patent application as having been filed as a continuation application under 37 CFR 1.53(b):

A request for a CPA expressly abandons the prior application as of the filing date of the request for the CPA. See 37 CFR 1.53(d)(2)(v). Therefore, where the prior application [here, the '814 application] is not to be abandoned, any continuation or divisional application must be filed under 37 CFR 1.53(b). If applicant wants the PTO to disregard a previously filed request for a CPA (and not recognize its inherent request

Applicant : David J. Luneau
Patent No. : 6,038,443
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Filed : June 10, 1996
Page : 4

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to expressly abandon the prior application) and to treat the paper as the filing of an application under 37 CFR 53(b), the applicant must file a petition under 37 CFR 1.182.

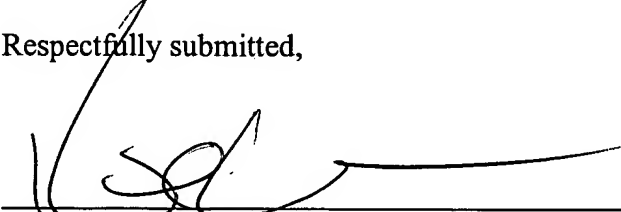
M.P.E.P. § 201.06(d) (emphasis added).

For the foregoing reasons, Applicant respectfully requests that the PTO disregard the previous request for a CPA, and to treat the March 14, 2000, patent application as having been filed on that date under 37 CFR 53(b).

A check for the fee (\$130) required by 37 CFR 1.17(h) is enclosed. Please charge any additional fees, or make any credits, due in connection with this response to Deposit Account No. 06-1050, reference 10200-007002.

Respectfully submitted,

Date: August 24, 2001


Kurt L. Glitzenstein
Reg. No. 39,686

Fish & Richardson P.C.
225 Franklin Street
Boston, Massachusetts 02110-2804
Telephone: (617) 542-5070
Facsimile: (617) 542-8906

20306663.doc

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OFFICE OF PETITIONS

Attorney Docket No. 10910-019 Client Lincoln
Date of Deposit 06/20/00

The Patent & Trademark Office acknowledges, and has stamped hereon,
the date of receipt of the items listed below concerning the following:

Patent Application Serial No. 10910-019 Filed: 3-4-2000
Patent No. _____ Issued: _____

Express Mail Certificate, Label No. _____

Transmittal Letter Small Entity Form Declaration/Power of Attorney

Specification, _____ number of pages Notice to File Missing Parts

Claims, _____ Independent _____ Multiple Dependent _____

Abstract _____ Sheets of Drawings _____ Petition to Make Special

Recordation Form Cover Sheet Transmittal of New Drawings

Assignment Petition for Extension of Time Fee Addressee

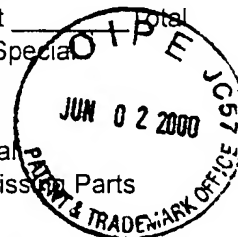
Amendment Appeal Brief Status Inquiry Notice of Appeal

Certificate of Mailing Issue Fee Transmittal Application w/ Missing Parts

Check in the Amount of \$ 100.00

Deduct Fee of \$ _____ from Deposit Account #500229

Other Petition under Section 1.121





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Attorney Docket No. 1090-019 Client Lunard
Date of Deposit 080300

The Patent & Trademark Office acknowledges, and has stamped hereon,
the date of receipt of the items listed below concerning the following:

Patent Application Serial No. 1090-019 Filed: 3-14-2000

Patent No. _____ Issued: _____

Express Mail Certificate, Label No. _____

Transmittal Letter Small Entity Form Declaration/Power of Attorney

Specification, _____ number of pages Notice to File Missing Parts

Claims, _____ Independent _____ Multiple Dependent _____ Total

Abstract _____ Sheets of Drawings _____ Petition to Make Special

Recordation Form Cover Sheet Transmittal of New Drawings

Assignment _____ Petition for Extension of Time _____ Fee Addressee

Amendment _____ Appeal Brief _____ Status Inquiry _____ Notice of Appeal

Certificate of Mailing _____ Issue Fee Transmittal _____ Application w/ Missing Parts

Check in the Amount of \$ 150.

Deduct Fee of \$ _____ from Deposit Account #500229

Other Refund under section 1.181

FL 492496788US



Docket No. 1090-019

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
Luneau, David J.)
Serial No. To be Assigned)
Filed: March 14, 2000)
For: CALLING PARTY ANNOUNCEMENT)
APPARATUS)

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AUG 29 2001

OFFICE OF PETITIONS

Box DAC
Commissioner of Patents and Trademarks
Washington, D.C. 20231

EXPRESS MAIL CERTIFICATE

Express Mail Label Number: EL492496788US
Date of Deposit June 2, 2000

I hereby certify that the following attached paper and fee:

Check in the Amount of \$130
Petition under §1.181
Exhibits A - E

as being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Commissioner of Patents and Trademarks, Washington, D.C. 20231.

William B. Ritchie, Esq.
Attorney for Applicant
Reg. No. 33,118
43 Jackson Street
Concord, NH 03301
603-225-5212



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Docket No. 1090-019

In re application of

Luneau, David J.

Serial No. To be Assigned

Filed: March 14, 2000

For: CALLING PARTY ANNOUNCEMENT
APPARATUS

Box DAC
Commissioner of Patents and Trademarks
Washington, D.C. 20231

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AUG 29 2001

OFFICE OF PETITIONS

PETITION UNDER §1.181

Applicant hereby petitions under 37 C.F.R. §1.181 that filing date of March 14, 2000 be granted to above-identification application.

FACTS

- 1) On March 10, 2000, applicant received notice that U.S. Patent No. 6,038,443 would issue on March 14, 2000. Exhibit A
- 2) At the request of the applicant, a continuing application was filed on March 14, 2000. This application properly referenced the '443 patent application as the parent. No filing fee was included but the name of the inventor was provided. This application was inadvertently identified as a "continued prosecution application CPA" rather than a "continuation" application which was clearly intended. Exhibit B
- 3) The application was sent via express mail, Exhibit C, and the return postcard indicates that the application was date stamped as March 14, 2000. Exhibit D.
- 4.) On April 10, 2000, the applicant received a Notice, dated April 7, 2000, that this application would not be granted the March 14, 2000 filing date. Exhibit E.

ARGUMENT

As held in *Transco Products Inc. v. Performance Contracting*, 32 USPQ2d 1077 (Fed. Cir. 1994), it is well established law that the various terms for continuing

applications are merely terms of administrative convenience and the bottom line is that, no matter what term is used to describe a continuing application, that application is entitled to benefit of the filing date of an earlier application as to common subject matter. The subject matter and the inventorship of this application are identical to the '433 patent.

It is also well established law that the entire '443 patent may be incorporated by reference, thereby providing a complete written description, claims, and drawings. See, MPEP 608.01(p)(B). Mr. Luneau was also named as the inventor in both applications. Therefore, this application was complete as required under 1.53(b) and should have been accorded the March 14, 2000 filing date, despite the inadvertent use of the term "CPA".

In light of the above, the applicant respectfully requests that the decision in the Notice dated April 4, 2000 be reversed and the filing date of March 14, 2000 be granted the above-referenced patent application.

Respectfully submitted,



William B. Ritchie, Esq.
Attorney for Applicant
Reg. No. 33,118
43 Jackson Street
Concord, NH 03301
603-225-5212



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARK
Washington, D.C. 20231

APPLICATION NUMBER	FILING /RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO./TITLE
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WILLIAM B. KILPATRICK
40 JACKSON STREET
CONCORD, NH 03301

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AUG 29 2001

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DATE MAILED: 04/07/00

NOTICE OF IMPROPER CPA FILING UNDER 37 CFR 1.53(d)
No Filing Date Granted

The Continued Prosecution Application (CPA) request deposited on _____ is improper under 37 CFR 1.53(d) and has not been granted a filing date for reason(s) indicated below:

Any assertions that the above-mentioned CPA request is proper under 37 CFR 1.53(d) must be by way of petition directed to the attention of the Office of Petitions. Any such petition must be accompanied by the \$130.00 petition fee (37 CFR 1.17(i)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

A petition under 37 CFR 1.53(e) as discussed above must be submitted within **TWO MONTHS** of the date of this notice (37 CFR 1.181(f)). THIS TIME LIMIT MAY NOT BE EXTENDED PURSUANT TO 37 CFR 1.136. Failure to timely file a petition under 37 CFR 1.53(e) will result in the CPA request being retained in the file of the prior application but treated as never having been filed, in which case applicant may request a refund of the CPA filing fee (if submitted) less the \$130.00 handling fee (37 CFR 1.21(n)).

- ☐ 1. The prior application is not a complete (37 CFR 1.51(b)) application or the national stage of a PCT international application that is in compliance with 35 U.S.C. 371.
- ☒ 2. The request for a CPA was not filed before the payment of the issue fee on the prior application. The issue fee was paid on the prior application on 12/13/99.
- ☐ 3. The request for a CPA was not filed before the abandonment of, or termination of proceedings on, the prior application. The prior application was abandoned, or proceedings terminated on _____.
- ☐ 4. A petition for an extension of time under 37 CFR 1.136(a) accompanied by the appropriate fee (37 CFR 1.17(a)) are necessary to establish copendency between the prior application and this CPA request.
- ☐ 5. OTHER: _____

A copy of this notice MUST be returned with the reply.

Direct any questions about this Notice to:
Jacqueline Dickerson
Examining Group 2746
(703) 306-5485

LAW OFFICES OF WILLIAM B. RITCHIE
43 JACKSON STREET
CONCORD, NH 03301
(603) 225-5212



1052

6/2/2000

PAY TO THE ORDER OF Commissioner of Patents and Trademarks

One Hundred Thirty and 00/100*****

\$ **130.00

DOLLARS

Commissioner of Patents
and Trademarks
Washington, D.C. 20231

MEMO: Luneau 1090-019 EXTENSION FEE

William B. Ritchie

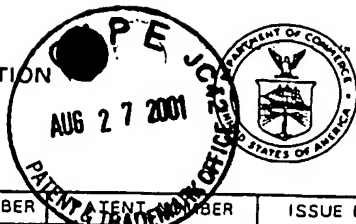
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ISSUE NOTIFICATION



UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
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OF PATENTS AND TRADEMARKS
Washington, D.C. 20231

APPLICATION NUMBER	PATENT NUMBER	ISSUE DATE	ATTORNEY DOCKET NO.
08/660,814	6038443	03/14/00	1090-006

8443
WILLIAM B RITCHIE
43 JACKSON STREET
CONCORD NH 03301

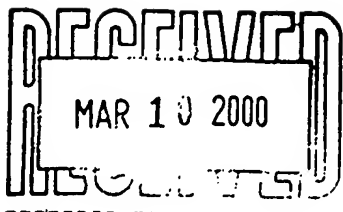
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APPLICANT(S) DAVID J. LUNEAU, HOPKINTON NEW HAMPSHIRE

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AUG 29 2001

OFFICE OF PETITIONS





US006038443A

United States Patent [19]

[11] Patent Number: 6,038,443

Luneau

[45] Date of Patent: *Mar. 14, 2000

[54] CALLING PARTY ANNOUNCEMENT APPARATUS

[76] Inventor: David J. Luneau, 274 Gage Hill Rd., Hopkinton, N.H. 03229

[*] Notice: This patent is subject to a terminal disclaimer.

[21] Appl. No.: 08/660,814

[22] Filed: Jun. 10, 1996

Related U.S. Application Data

[63] Continuation-in-part of application No. 08/303,534, Sep. 9, 1994, Pat. No. 5,526,406, and a continuation-in-part of application No. 07/827,262, Jan. 29, 1992, abandoned.

[51] Int. Cl.⁷ H04M 11/00

[52] U.S. Cl. 455/415; 379/88.21; 379/142

[58] Field of Search 379/142, 265, 379/67, 88, 88.19, 88.2, 88.21, 88.22, 88.23, 88.24; 455/415, 414, 38.2, 459

[56] References Cited

U.S. PATENT DOCUMENTS

4,899,358	2/1990	Blakely	379/67
4,924,496	5/1990	Figa et al.	379/142
5,452,346	9/1995	Miyamoto	379/142
5,467,385	11/1995	Reuben et al.	379/88
5,481,594	1/1996	Shen et al.	379/142
5,511,111	4/1996	Serbercioglu et al.	455/414
5,546,448	8/1996	Caswell et al.	379/88

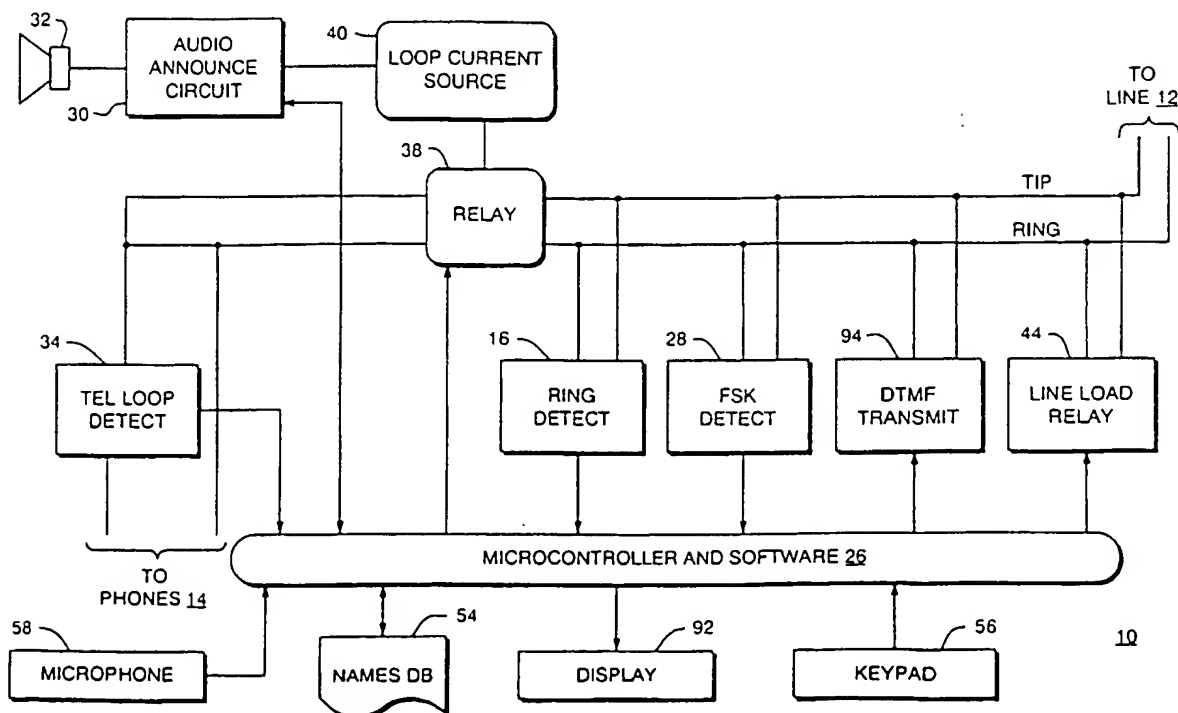
Primary Examiner—Lee Nguyen

Attorney, Agent, or Firm—Michael J. Persson; William B. Ritchie

[57] ABSTRACT

A calling party announcement apparatus that provides the identity of the caller in synthesized human speech. The invention captures the Incoming Caller Line Identification (ICLID) signal sent by the telephone company. The invention announces the calling party's identity to the called party through a built-in speaker and over the telephone receiver. The called party can elect to accept or reject the call before the telephone company central office has connected the two parties together. The invention makes it possible to screen incoming telephone calls without the aid of a special Caller ID telephone set or auxiliary Caller ID display terminal. The invention is installed in the customer premises, such as a residence or office, between the telephone line demarcation point and the telephone sets. The invention is compatible with any standard telephone set and subscriber trunks provisioned with the Caller ID enhanced customer feature. One of the most important features of the invention is its ability to deliver a vocalized announcement of the caller's identity over a standard telephone set's receiver without the call having actually been declared answered by the telephone company, and without the caller having been cut through. The call is not considered "answered" nor is it billed by the telephone company unless the called party or a telephone answering device, such as an answering machine, accepts the call.

14 Claims, 6 Drawing Sheets





Docket No. 1090-006
Express Mail No. EL384499714US

Assistant Commissioner for patents
Box CPA
Washington, D.C. 20231

**CONTINUED PROSECUTION APPLICATION
REQUEST TRANSMITTAL**

Transmitted herewith for filing is the patent application of David J. Luneau for:
CALLING PARTY ANNOUNCEMENT APPARATUS. This application is a continued
prosecution application of U.S. Patent Application Serial No. 08/660,814, filed June 10,
1996.

Papers enclosed are:
Post Card
Express Mail Certificate

Fee Calculations:
Regular application – small entity
Total Claims – 0 Extra
Independent Claims – 0 Extra
Multiple Dependant Claims – None

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The application is being filed without the filing fee. In that the specification, claims and
name of the actual inventors has been provided, pursuant to 37 C.F.R. §1.53 (b), the
enclosed application should be accorded to the Express Mail Certificate date under 37
C.F.R. §1.10(c).

Respectfully submitted,

William B. Ritchie
Attorney for Applicant
Reg. No. 33,118
43 Jackson Street
Concord, NH 03301
603-225-5212



Docket No. 1090-006

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of)
Luneau, David J.)
Serial No. 08/660,814)
Filed: June 10, 1996)
For: CALLING PARTY ANNOUNCEMENT)
APPARATUS)

Assistant Commissioner for Patents
Box CPA
Washington, D.C. 20231

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OFFICE OF PETITIONS

EXPRESS MAIL CERTIFICATE

Express Mail Label Number: EL384499714US

Date of Deposit 3-14-00

I hereby certify that the following attached paper and fee:

Continued Prosecution Application Request Transmittal

as being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR 1.10 on the date indicated above and is addressed to the Assistant Commissioner of Patents and Trademarks, Washington, D.C. 20231.


William B. Ritchie, Esq.

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OFFICE OF PETITIONS

Attorney Docket No. 1000-000
Date of Deposit 031400

Client LPN

The Patent & Trademark Office acknowledges and has stamped herein the date of receipt of the items listed below concerning the following:

☒ Patent Application Serial No. 08/600,314 Filed: 11-10-96

☐ Patent No. _____ Issued: _____

☒ Express Mail Certificate, Label No. E138447714

☐ Transmittal Letter ☐ Small Entity Form ☐ Declaration/Power of Attorney

☐ Specification, _____ number of pages ☐ Notice to File Missing Parts

☐ Claims, _____ Independent _____ Multiple Dependent

☐ Abstract ☐ _____ Sheets of Drawings ☐ Petition to Make Special

☐ Recordation Form Cover Sheet ☐ Transmittal of New Drawings

☐ Assignment ☐ Petition for Extension of Time ☐ Fee Addressee

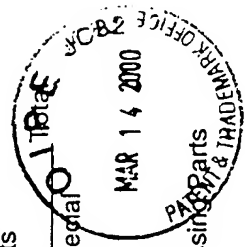
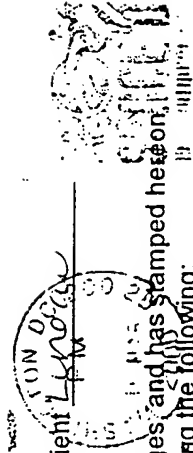
☐ Amendment ☐ Appeal Brief ☐ Status Inquiry ☐ Notice of Appeal

☐ Certificate of Mailing ☐ Issue Fee Transmittal ☐ Application w/ Missing Parts

☐ Check in the Amount of \$ _____

☐ Deduct Fee of \$ _____ from Deposit Account #500229

Other CPA





UNITED STATES DEPARTMENT OF COMMERCE
Patent and Trademark Office
Address: COMMISSIONER OF PATENTS AND TRADEMARK
Washington, D.C. 20231

APPLICATION NUMBER	FILING /RECEIPT DATE	FIRST NAMED APPLICANT	ATTORNEY DOCKET NO./TITLE
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#16

DATE MAILED:

NOTICE OF IMPROPER CPA FILING UNDER 37 CFR 1.53(d)
No Filing Date Granted

The Continued Prosecution Application (CPA) request deposited on _____ is improper under 37 CFR 1.53(d) and has not been granted a filing date for reason(s) indicated below:

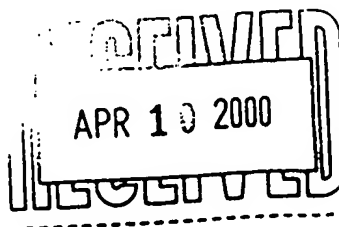
Any assertions that the above-mentioned CPA request is proper under 37 CFR 1.53(d) must be by way of petition directed to the attention of the Office of Petitions. Any such petition must be accompanied by the \$130.00 petition fee (37 CFR 1.17(i)). If the petition alleges that no defect exists, a request for refund of the petition fee may be included in the petition.

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- ☒ 2. The request for a CPA was not filed before the payment of the issue fee on the prior application. The issue fee was paid on the prior application on 12/13/99.
- ☐ 3. The request for a CPA was not filed before the abandonment of, or termination of proceedings on, the prior application. The prior application was abandoned, or proceedings terminated on _____.
- ☐ 4. A petition for an extension of time under 37 CFR 1.136(a) accompanied by the appropriate fee (37 CFR 1.17(a)) are necessary to establish copendency between the prior application and this CPA request.
- ☐ 5. OTHER: _____

A copy of this notice MUST be returned with the reply.

Jacqueline Dickerson
Direct any questions about this Notice to:
Jacqueline Dickerson
Examining Group 2746
(703) 306-5485



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